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Date: November 21, 2008 Name: Richard G. Lione, Reg. No. 19,795 Signature: /Richard G. Lione/

Case No. 5404/170

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Toshiyukia Masuda

International Serial No:
PCT/JP2005/004627

U.S. Serial No.: 10/590,089

International Filing Date: March 16, 2005

U.S. Filing Date: August 21, 2006

For: FLAME-RETARDANT POLYESTER ARTIFICIAL HAIR

Examiner: Peter A. Szekely

Group Art Unit: 1796

Confirmation No. 4150

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action of August 21, 2008, applicant respectfully requests reconsideration and withdrawal of the prior art rejections based on 35 U.S.C. § 103(a) which are presented in the Office Action. The Office Action contains twelve separate and independent rejections, each based on two different references, which contend that the invention defined by independent Claim 1 (and dependent Claims 2-11) would have been obvious to one of ordinary skill in the relevant art at the time of the Applicant's invention. Applicant respectfully submits, however, that not one of these prior art reference combinations, much less twelve (12) of them,

comprise a legally sufficient by the U.S. Supreme Court rejection required by KSR Int'l Co. v. Teleflex, Inc., 82 USPQ 2d 1385 (2007).

The U.S.C. § 103(a) rejections made in the Office Action rely upon each of the following cited prior art combinations:

1. Maeda et al. in view of Izutu et al.;
2. Maeda et al. in view of Fujimoto et al.;
3. Maeda et al. in view of Ohara et al.;
4. Maeda et al. in view of Nakaura et al.
5. Sone et al. in view of Izutu et al.;
6. Sone et al. in view of Fujimoto et al.;
7. Sone et al. in view of Ohara et al.;
8. Sone et al. in view of Nakaura et al.
9. Hawtin et al. in view of Izutu et al.;
10. Hawtin et al. in view of Fujimoto et al.;
11. Hawtin et al. in view of Ohara et al.;
12. Hawtin et al. in view of Nakaura et al.

However, the fact is that each of the twelve rejection combinations is fatally deficient from a prima facie obviousness standpoint. Of the Izutu et al., Fujimoto et al., Ohara et al. and Nakaura et al. references, not one discloses or suggests the use of the claimed composition as artificial hair composition, and no motivation is found in the prior art for combining them with Maeda et al., Sone et al. or Hawtin et al. What is described by each of Izutu et al., Fujimoto et al., Ohara et al. or Nakaura et al. is not the intrinsic viscosity of an artificial hair composition but the intrinsic viscosity of the polyester (e.g., polyethylene terephthalate) which is contained in the composition. Thus, the rejections are each based on an incorrect fact premise, ab initio, and none of the combinations of the above-mentioned reference pairs could have suggested the Claim 1 invention.

In addition, according to the Claim 1 invention, by maintaining the intrinsic viscosity of the hair composition in a range of 0.5 to 1.4, a result that is neither described nor taught by any of the above-mentioned cited references is exhibited.

As described on page 16, lines 1-8 of the applicants English specification, the applicant explains that:

> "The composition of the present invention obtained by melt kneading the components (A), (B) and (C) can have a excellent spinning property by controlling the amount of component (C) and adjusting the intrinsic viscosity to 0.5 to 1.4. The composition has an intrinsic viscosity of preferably 0.5 to 1.4, and more preferably 0.6 to 1.2. If the intrinsic viscosity is less than 0.5, the resulting fiber tends to have reduced mechanical strength. If more than 1.4, the melt viscosity is increased as the molecular weight is increased, and thus the fiber tends to be melt spun only with difficulty, and to have a non-uniform size."

Also, the claim 1 invention describes an unpredictable effect that is not recognized by any of the cited references. As described on page 5, lines 7-15 and Table 2 of the English specification, the applicant states:

> "In order to solve the aforedescribed problems, the inventors have conducted intensive studies. They have found that a flame retardant polyester based artificial hair which have excellent spinning processability, maintains fiber properties such as heat resistance, strength and elongation and the like and also has excellent curl holding properties and iron setting properties, can be obtained by melt spinning a composition comprising a polyester, a phosphorus containing flame retardant and and/or a bromine containing flame retardant and at least one compound selected from the group consisting of a carbodiimide compound, a bisoxazoline compound and an isocyanate compound." (see also Table 2)

The sum and substance of applicant's argument on the subject 35 U.S.C. § 103(a) rejections relying on a combination reference is that a reject on must show reasons that the skilled artisan confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed.* Failing that, the

rejection must be withdrawn. In the case at issue, none of the aforedescribed rejections have met the required burden.

Respectfully submitted,

Dated: November 21, 2008

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